

REMARKS

The Examiner has rejected claims 1 through 8 under 35 USC 112, alleging that the reference to the filter assembly being "disposed in series flow relationship" is inaccurate. However, it can be seen clearly from the schematic of FIG. 2 that in fact the filter assembly (81) is in a series flow relationship between the source of fluid (C) and the various recited inlets and outlets (63 and 65). Accordingly, Applicants believe that this basis for rejection has been overcome and should be withdrawn.

The Examiner has also rejected claims 1 through 8 under 35 USC 112, alleging that the reference to the "disk-like portion" is a "relative term" and therefore indefinite, further alleging that the term is not defined. However, Applicants believe that anyone even slightly skilled in the art would understand the term to refer to the generally annular portion shown so clearly in FIGS. 3, 4 and 5. Applicants believe that anyone even slightly skilled in the art would clearly understand the scope of the claims based upon the drawing figures and a reading of the specification. Applicants believe that this rejection has been overcome and should be withdrawn.

The Examiner has rejected claims 1 through 4 and 6 under 35 USC 102(b) as being anticipated by U.S. 4,843,818. However, none of the reference numerals noted by the Examiner match those utilized in the '818 patent, and therefore, Applicants will assume that the Examiner meant to base the rejection upon U.S. 4,686,829.

In support of the rejection of claim 1, the Examiner notes various elements from the '829 reference, apparently referring primarily to the embodiment of FIGS. 1 and 2, based upon the reference numerals utilized by the Examiner in the rejection. For example, putting the reference numeral "(8)" after a recitation of a "pump inlet". Unfortunately, the Examiner then pretends that FIG. 1 shows a motor, or at least the inlet and outlet of a motor, when in fact FIG. 1 of the '829 reference shows only a pump.

It is true that the embodiment of FIG. 5 of the '829 reference does show both a pump and motor, and the type of journal or pintle (85) common in such pump motor units but it is important for purposes of the present invention to note that the embodiment of FIG. 5 does not include any sort of filter element.

Referring again to the Examiner's analysis of claim 1 of the present invention, the Examiner alleges that element (a) of claim 1 is anticipated by the '829 reference

which allegedly teaches a "recessed area", citing chamber 12 and passages 54 of the '829 patent. It should be noted that element (a) of claim 1 further defines the "recessed area" as being located "between said source of low pressure fluid and said pump inlet". In view of the above amendment of claim 1, it is even more clear than it was before that the elements 12 and 54 of the '829 reference do not teach the "recessed area" of the claim.

In regard to element (b) of claim 1, the Examiner alleges that the '829 reference teaches that the filter assembly comprises "a piece of filter material disposed within said recessed area", overlooking the fact that the filter element 53 in FIG. 1 of the '829 reference is **upstream** of the elements 54 and 12 which the Examiner has previously alleged as the teaching of the claimed "recessed area". Applicants do not believe that the Examiner can have it both ways.

In regard to the Examiner's analysis of the '829 reference as it applies to claim 2 of the application, the Examiner is correct, but only to the extent that the embodiment of FIG. 5 includes both a pump and motor, as noted previously, and recognizing that that embodiment does not include a filter element.

In regard to the Examiner's analysis of claim 3 of the application, there is a reference to a "disk-like portion" followed by a reference to the numeral "15" which is actually a washer disposed on the outside of the end cover (11) in FIG. 1 of the '829 reference. It is clear that in the FIG. 1 embodiment, there is no structure which corresponds to the disk-like portion (61) of claim 3.

In the Examiner's analysis of claim 4, he makes the incredible statement that the '829 reference discloses the disk-like portion "defining said recessed area" when FIG. 1 of the '829 reference clearly has nothing corresponding to the claimed disk-like portion (61) of the invention, and what the Examiner has alleged (washer 15) as the corresponding structure clearly does not teach what the Examiner has alleged to be the "recessed area" (chamber 12 and passages 54).

In regard to the Examiner's analysis of claim 6, he can only be referring to the FIG. 5 embodiment in alleging that the '829 reference discloses the disk-like portion being disposed between the pump and the motor (in view of the fact that the FIG. 1 embodiment doesn't include a motor) and then follows up that statement with the incredible allegation that the disk-like portion (which would now be the plate 70 shown in FIG. 5 of the '829 reference) defines "said recessed area . . .". This is clearly impossible in view of the fact that elements (a) and (b) of claim 1 contain a recitation

that the filter element is disposed in "said recessed area" and since there is no filter element in FIG. 5 of the '829 reference, there cannot be any structure which satisfies the claim limitation of a "recessed area".

Similarly, the Examiner's analysis of claim 7 is also based on the FIG. 5 embodiment, because he refers to the check valve (112) and then talks about it being disposed to permit flow through the filter assembly when there is no filter assembly in the FIG. 5 embodiment.

Applicants believe that the rejection of claims 1 through 4 and 6 under 102(b) as anticipated by Thoma (presumed to be the '829 reference) has been overcome and should be withdrawn.

The Examiner has rejected claim 5 under 35 USC 103(a) as unpatentable over Thoma in view of Suzuki. The Suzuki reference is directed to a filter apparatus (20) connected to the outlet of a canister mounted on a fuel supply system. There is clearly nothing in either the Thoma reference or the Suzuki reference which would suggest a combination of the two references. Applicants readily concede that flat, pleated pieces of filter material are known in the art and have been for many years, but such does not result in either the anticipation of or the obviousness of the claimed invention. In applying the Suzuki reference, the Examiner alleges the obviousness of putting the piece of filter material "within said recessed area" when in fact, the Examiner has not applied to the claims a reference having a "recessed area" which is the same structurally or functionally as that illustrated, described, and claimed herein.

In summary, Applicants have amended the main independent claim to further emphasize one of the many differences over the cited art and have attempted to explain such differences. Applicants believe that the case is now in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



L. J. Kasper

Registration No.: 26,749

Attorney for Applicant

Eaton Corporation
1111 Superior Avenue
Cleveland, Ohio 44114-2584
(216) 523-4138